

D2 8. (Twice Amended) Apparatus according to claim 6, wherein the lower guideway is adjustably engaged to the stable support.--

REMARKS

The Office Action dated November 29, 2002, has been carefully considered. In response thereto, the following remarks have been prepared. Applicant respectfully submits that the application is in condition for allowance. Accordingly, reconsideration and withdrawal of the outstanding Office Action and issuance of a Notice of Allowance are respectfully requested.

Claims 1-5, 7-26 and 28-35 are pending in the application (claims 6 and 27 were cancelled in previous Amendments). In the Office Action, the Examiner has rejected those claims under 35 U.S.C. §§ 103(a), 112, first paragraph, and 112, second paragraph. The Examiner has also objected to the specification. For the following reasons, Applicant respectfully traverses those rejections and objection and seeks reconsideration by the Examiner in light of the following remarks.

Rejection of Claims Under 35 U.S.C. § 112, First Paragraph

The Examiner has rejected claims 29, 30, 32, 33 and 35 under 35 U.S.C. § 112, first paragraph. In particular, the Examiner asserts that there is insufficient support in the disclosure for the lower guideway to be "slack" and that nowhere has it been stated why the lower guideway should be slack and how that would differ from a taut line. As noted below, Applicant respectfully submits that the disclosure provides adequate support for the claim term "slack" and that the specification is in conformance with § 112, first paragraph. Applicant also submits that one of ordinary skill in the art would understand from a review of the specification why and how the lower guideway is not taut.

Together, the drawings and text contain, with reasonable clarity, the identifying characteristics of the slack feature of claimed invention. In the embodiment of the invention shown in FIG. 1, for example, the lower guideway is depicted as a wavy solid line, indicating the structure of the guideway when it is at rest. See, e.g., Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1565, 19 USPQ2d 1111, 1118 (noting that drawings alone may provide a “written description” of an invention as required by § 112). The lower guideway is described in the specification as a plastic-coated cord or wire-like structure (see page 6 of the application and claim 14). Applicant submits, therefore, that one of ordinary skill in the art would conclude that the cord possesses some inherent flexibility (i.e., it can bend). As further shown in FIG. 1, the two ends of the lower guideway are fixed to two separate and spaced apart upstanding supports. One of ordinary skill in the art would understand that if the axial length of the lower guideway is greater than the linear distance between the two points where it attaches to the supports, then the lower guideway must possess at least one bend along its length (i.e., it will not always be linear at rest). That would be the case, for example, where the two points where the lower guideway attaches to the stable supports are approximately 10 meters apart (see FIG. 1) and the length of the lower guideway is, say, 10.5 or 15 meters. For a flexible, plastic-coated cord or wire-like structure to accommodate those dimensions it must have one or more bends along its length.

That arrangement is what is depicted in FIG. 1 and described in the text of the specification. First, as noted above, the slack feature of the lower guideway is clearly depicted in FIGS. 1-3. Second, the slack feature is also described in the text of the specification. For example, as the Examiner notes, page 6 of the application states that “[t]wo positions of the lower guideway are shown in Figure 1, these being shown in full line and broken line.” Page 7 of the application states that “[t]he force of the strike [from the player] sends the lines 8, 9 and the ball 7 along the upper and lower guideways 1, 2 toward the limiting position shown in broken line. Once the distance between the ends of the lines 8, 9 (the lower guideway 2 now being in its raised position shown in broken line) becomes limiting in relation to the distance between the upper and lower guideways, the lines 8, 9 slow down, stop and are deflected back along the

upper and lower guideways to return to the player who can then strike the ball again.” Applicant submits that based upon the drawings and accompanying disclosure in the application, it is evident that for the lower guideway to be arranged in those two positions (i.e., initial and raised) and for it to function as described, there must be some “slack” as recited in the claims and shown by the wavy solid line on FIG. 1 (as well as on FIGS. 2 and 3). Therefore, the disclosure provides adequate support for the claim term “slack” and a person of ordinary skill in the art would understand and recognize that Applicant had possession of the claimed invention at the time of filing the subject patent application. The fact that the term “slack” does not appear in the disclosure as filed does not prevent its introduction now to describe what is shown and described in the original disclosure. See Crown Operations International Ltd. v. Solutia Inc., 62 U.S.P.Q.2d 1917, 1922 (Fed. Cir. 2002) (“In order to satisfy the written description requirement, the disclosure as originally filed does not have to provide in haec verba support for the claimed subject matter at issue.”) (citations omitted).

why
(2.) | Moreover, contrary to the Examiner’s assertion, the specification does indicate, and with reasonable clarity, why the lower guideway is slack in the initial position and how that differs from a taut line. In fact, as described below, there is only one reasonable conclusion that one of ordinary skill in the art could make regarding the nature of the lower guideway as depicted by the two positions of the guideway shown on FIG. 1. Consider a left-handed batter or golf player standing near the stable support 3 with his back to an observer looking into the page of FIG. 1 at the side of the apparatus. The batter is between the observer looking into the page of FIG. 1 and the ball 7. As described in the specification, the force of the strike from the player sends the lines 8, 9 and the ball 7 along the upper and lower guideways 1, 2 toward the limiting position shown in the broken line shown on FIG. 1. That is, if the player elevates the ball 7 into the air, as would be expected for a batter or golf player hitting the ball, the position of the lower guideway would also elevate as shown by the broken line relative to the solid wavy line in FIG. 1. Once the distance between the ends of the lines 8, 9 (the lower guideway 2 now being in its raised position shown in broken line) becomes limiting in relation to the distance between the

upper and lower guideways, the lines 8, 9 slow down, stop and are deflected back along the upper and lower guideways to return to the player who can then strike the ball again. In other words, the lower guideway does not have to be taut before the ball is struck by a player. One of ordinary skill would understand that there is a difference between the slack guideway in the rest position and the taut guideway in the raised position shown in the embodiment of FIG. 1.

Thus, given the cord or wire-like nature of the lower guideway, its inherent flexibility, and the description of the two positions of the lower guideway before and after the ball 7 is struck by a player in the specification, Applicant submits that claims 29, 30, 32, 33 and 35 are fully supported by the disclosure of the application as originally filed. Withdrawal of the rejection of those claims under § 112, first paragraph, and allowance is requested.

For the same reasons, the axial length of line 9, as measured between the point where it attaches to the ball 7 on one end and the point where it attaches to the loop or ring 11, must be greater than the linear distance between the bottom of the ball 7 and the loop or ring 11 when the apparatus is in the pre-struck position shown in FIG. 1. Thus, line 9 also possesses some “slack” as recited in the claims and shown by the wavy line on FIG. 1.

Rejection of Claims Under 35 U.S.C. § 112, Second Paragraph

The Examiner has rejected claims 2-4, 8 and 21 under 35 U.S.C. § 112, second paragraph. With regard to claim 2, that claim has been amended in accordance with the Examiner’s suggestion.

With regard to claim 3, that claim recites the following: “the upper and lower guideway are substantially parallel.” That limitation is consistent with amended claim 1, in which it is recited that both guideways can be “generally inclined.” Thus, the two guideways can be parallel to each other if they are both generally inclined at substantially the same angle relative to the ground. Accordingly, Applicant submits that no change to claim 3 is necessary and that the claim is proper.

With regard to claims 4 and 21, those claims recite that the upper and lower guideways lie in a plane that is normal to the ground. Those recitations, therefore, encompass a situation in which the upper and lower guideways are not parallel to each other but still ~~lie~~ in the same plane. That is, the upper guideway can be inclined and the lower guideway can be parallel to the ground and still lie in the same plane that is normal to the ground. Accordingly, Applicant submits that no change to claims 4 and 21 are necessary and that those claims are proper.

With regard to claim 8, that claim has been amended to depend from claim 6 and to clarify that the lower guideway is adjustable relative to the stable support.

Rejection of Claims 1-5, 7-9, 11-15, 18, 19, 28 and 34 Under 35 U.S.C. §103(a)

The Examiner has rejected claims 1-5, 7-9, 11-15, 18, 19, 28 and 34 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,630,521 to *Lingbeek* in view of U.S. Patent No. 3,086,775 to *Albert* and U.S. Patent No. 5,713,805 to *Scher et al.* or in the alternative U.S. Patent No. 5,460,364 to *Ring*. For the following reasons, Applicant submits that those claims, as amended, are clearly patentably distinguished over any one, or a combination of, the cited references.

As the Examiner acknowledges, *Lingbeek* fails to show each and every feature recited in amended claim 1. In particular, *Lingbeek* fails to disclose an apparatus with a “generally inclined upper guideway” or an “inelastic reciprocating means.” What *Lingbeek* does disclose, however, is a device with parallel upper and lower guideways that are approximately horizontal to the ground, stretched between two spaced apart upright posts and spanned by an *elastic* cord with a ball connected thereto (see Figure 1).

According to *Lingbeek*, the parallel upper and lower guideways, combined with the *elastic* nature of the cord, form an apparatus whereby the ball, after extending to the farthest position shown in Figure 1 after being struck by a batter, returns to the batter “with approximately the same speed at which it was hit.” In fact, applicant submits that the proportional speed and trajectory of the ball returning to the batter is an essential element of the

teaching of *Lingbeek* (see col. 1, lines 5-6: “[the ball] return[s] to the batter at approximately the same speed at which it was hit”; col. 1 line 20-24: “[a]nother object of this invention is to provide a device...[with] change of speed pitches according to the force the ball was hit”; col. 2, lines 20-23: “[the ball] snap[s] back to the batter with approximately the same speed as it was hit”; and col. 2, lines 27-28: “change of speed pitches are produced according to the force the ball was hit previously.”).

That is, due to the arrangement of the parallel and taut guideways that are spanned by an elastic cord, the speed of the returning ball is only a function of the force applied to it by the batter, not due to any mechanical arrangement of the guideways. Thus, *Lingbeek* teaches away from inclining the upper guideway to alter the speed of the returning ball, since inclining the upper guideway would alter the ball’s speed.

Albert teaches that raising one end of the upper guideway will increase the “rate of approach of the ball to the batter” (see *Albert*, col. 2, lines 31-33). That is, because the ball in *Albert* is suspended from the upper guideway and moves back to the batter by the force of gravity, raising the end of the upper guideway will cause the ball to drop farther (and, hence faster), upon its return to the batter after being struck. *Lingbeek*, as noted above, is concerned with maintaining the velocity of the ball upon returning to the player at approximately the same as the speed as it left the player’s bat. That essential feature of *Lingbeek* would be destroyed by raising one end of the upper guideway. Indeed, that is why, as the Examiner points out in her detailed comments, *Lingbeek* fails to disclose an apparatus with a “generally inclined upper guideway.” Accordingly, contrary to the Examiner’s assertion, one of ordinary skill in the art would not have modified *Lingbeek* in view of the teaching of *Albert* by raising one end of the upper guideway. Therefore, amended claim 1 is not unpatentable over *Lingbeek* in view of *Albert*.

Moreover, as noted above, an essential feature of *Lingbeek* is the elastic nature of the cord. In fact, *Lingbeek* only discloses a cord that “allows suitable springy action” (see col. 1, lines 46-47). The elastic cord is necessary since the upper and lower guideways are parallel. As

taught by *Lingbeek*, the change in the ball's speed and trajectory upon returning to the batter is related to the force applied to the ball by the batter and the elastic nature of the cord. Thus, because the cord is elastic, a stronger batter could alter the ball's return speed and trajectory at a level that a weaker play could not by simply striking the ball harder. There is no teaching or suggestion in *Lingbeek* that the device can or should be operated differently for weak or strong players by modifying the arrangement of the components or substituting the elastic cord for an inelastic one. The *Lingbeek* device already accommodates the strength of various players. Thus, contrary to the Examiner's assertion, one of ordinary skill in the art at the time of the invention would not have substituted the elastic reciprocating means of *Lingbeek* with a substantially inelastic reciprocating means as disclosed in *Scher et al.* and described by *Ring* in order to accommodate and meet the strength of various players. Therefore, amended claim 1 is not unpatentable over *Lingbeek* in view of *Scher et al.* and/or *Ring*.

For those reasons, Applicant submits that claim 1 is patentably distinct over *Lingbeek* in view of *Albert*, *Scher et al.* and/or *Ring*. Since claims 2-5, 7-9, 11-15, 18, 19 and 28 depend from claim 1, those claims are also patentable over the same combination of cited patents. Allowance is respectfully requested.

With regard to claim 34, the same remarks presented above with respect to claim 1 also apply with respect to claim 34. Accordingly, Applicant submits that claim 34 is patentably distinct over *Lingbeek* in view of *Albert*, *Scher et al.* and/or *Ring* and claim 35, which depends from claim 34, is also patentable over those references. Allowance of claims 34 and 35 is also respectfully requested.

Rejection of Claims 10, 16, 17, 20-26, 29-33 and 35 Under 35 U.S.C. §103(a)

The Examiner has rejected claims 10, 16, 17, 20-26, 29-33 and 35 under 35 U.S.C. § 103(a) as being unpatentable over *Lingbeek* in view of *Albert* and *Scher et al.* or in the alternative to *Ring*, as applied to claim 1, and further in view of U.S. Patent No. 4,138,107 to *Janis*. For the following reasons, Applicant respectfully submits that those claims, as amended,

are clearly patentably distinguished over any one, or a combination of, the cited patent references.

First, with regard to the references as applied to claim 1, Applicant submits that claim 1 is patentably distinct over the cited patents. *Janis* provides no additional teaching or suggestion that *Lingbeek* should be modified to encompass the rejected claims. Since claims 10, 16 and 17 depend from claim 1, those claims are also considered patentable over the combination of cited patents.

With regard to amended claim 20, since that claim includes features similar to claim 1, Applicant submits that claim 20, and dependent claims 21-26, are also patentable over the cited references.

With regard to claim 29, which recites “wherein the lower guideway between the first and second upstanding stable supports is slack when the ball is at rest,” Applicant reiterates the previous arguments with respect to combining *Lingbeek* and *Albert*. Moreover, it is not clear how *Albert* provides any teaching or suggestion to modify the taut lower guideway of *Lingbeek* and make it slack or “semi-slacked” so as to confine the movement of the ball and provide a more controlled practice device. First, *Albert* does not even have a lower guideway. Second, one of the objects of the *Lingbeek* device is “a device that is easily installed by *stretching two wires*, such as clothesline wires, between two uprights” (col. 1, lines 26-27) (emphasis added). According to that statement, *Lingbeek* teaches away from a lower guideway that is slack or semi-slacked because the term “stretching” suggests that any slack in the line has been removed. Third, *Lingbeek* teaches that the ball is “horizontally guided and *controlled by the wires*” after it is struck. Thus, there is no teaching or suggestion in *Lingbeek* to modify the lower guideway to provide for additional confinement of the ball or to create a more controlled practice device. Accordingly, Applicant submits that claim 29 is patentable over the cited references and allowance is requested.

In reaching the rejection of claim 29, the Examiner has taken official notice of the following: “the slack a line provides an inelastic line the resiliency or “slack” than an elastic line

inherently posses, which in turn allows the ball to travel more freely along the guideway(s).” In accordance with M.P.E.P. § 2144.03, Applicant wishes to make the following traverse of that assertion.

As best understood from the Examiner’s assertion, an inelastic line that is not stretched taut between its ends has some slack in it and that slack is the same as the resiliency or “slack” that an elastic line inherently possesses. It is not clear that the Examiner’s comparison is “well known” or supported by the references of record since no basis for the statement has been provided. Therefore, Applicant requests that the Examiner cite a reference in support of her position or, if the basis for the statement is within personal knowledge, Applicant respectfully requests that the data or facts supporting the assertion be included in the record. Applicant submits that one of ordinary skill in the art, when viewing the present specification and cited art, would not have understood that a cord or wire-like guideway having some slack between its ends is the same as or interchangeable with a taut elastic line having resiliency or elasticity properties.

With regard to claim 30, which recites “wherein a portion of the one or more upstanding lines between the ball and the lower guideway is slack when the ball is at rest,” Applicant agrees with the Examiner that *Lingbeek* does not show slack in the line between the ball and the lower guideway. However, Applicant disagrees with the Examiner’s assertion that *Albert* shows a line with slack. In fact, *Albert* does not teach or suggest a line between the ball and the lower guideway that is slack when the ball is at rest because *Albert* does not even have a line *between* the ball and a lower guideway. That is, there is no lower guideway in *Albert* so there cannot be a line or lines between the ball and a lower guideway. Moreover, the line between the ball and the upper guideway in *Albert* does not have any slack in it (see Figure 2). The ball-supporting line in *Albert* is actually a link chain 23 surrounded by a rugged rubber tubing or hose 30 for protection; there can be no slack in the line when the ball 25 is at rest since gravity will act on the ball and remove any slack in the link chain. Accordingly, Applicant submits that claim 30 is patentable over the cited references and allowance is requested.

With regard to claim 31, please see Applicant's previous arguments with respect to claim 28 (which depends from claim 1). With regard to claims 32-33 and claim 35, please see Applicant's previous arguments relevant to those claims. Allowance of those claims is also requested.

Objection of the Specification

With respect to the Examiner's objection of the specification noted on the Office Action Summary page (Box 9), Applicant has not identified in the Examiner's detailed comments any reasons or basis for that objection other than the §112 rejections, which have been addressed.

Accordingly, for the foregoing reasons, Applicant respectfully requests that the Examiner's objections and rejections of the specification and the pending claims be withdrawn and a Notice of Allowance be issued.

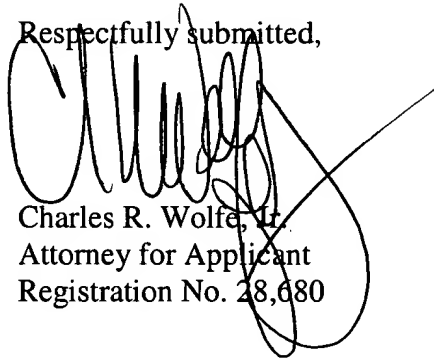
Please charge any shortage or credit any overpayment of fees to Deposit Account No. 23-2185 (112134-00102). In the event that a petition for an extension of time is required to be submitted herewith and in the event that a separate petition does not accompany this response, the Applicant hereby petitions under 37 CFR § 1.136(a) for an extension of time for as many months as are required to render this submission timely. Any fee due is authorized above.

Finally, attached hereto is a marked-up version of the changes made to the claims by the current Amendment. The attached page is captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE."

Serial Number: 09/582,556
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If there are any questions relating to this amendment or the application in general, it would be appreciated if the Examiner would telephone the undersigned attorney.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Charles R. Wolfe, Jr.', is written over the typed name and registration number.

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims

--2. (Once Amended) Apparatus according to claim 1 wherein [the upper guideway is inclined,] the maximum height of the inclined upper guideway above ground level [being] is greater than the length of the reciprocating means.

8. (Twice Amended) Apparatus according to claim [1] 6, wherein the lower guideway is adjustably engaged [with the ground] to the stable support.--